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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,135	06/30/2000	Jan-Dieter Spalink	FOV0001-US	9698

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EXAMINER

DINH, MINH

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/608,135	Applicant(s) SPALINK ET AL.	
	Examiner Minh Dinh	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the RCE/amendment filed 09/11/06.

Claims 1 and 10 have been amended; claims 14-27 have been cancelled.

Response to Arguments

2. Applicant's arguments, see the last paragraph of page 5 and first full paragraph of page 6, filed 09/11/06, with respect to the rejection(s) of claims 1-13 under 35 USC 112, second paragraph for omitting the step of "receiving the anonymized identifier and information identifying the transmitted data that is associated with the anonymized identifier from the network service provider" have been considered and are persuasive. Therefore, the rejection has been withdrawn. However, Applicant's amendments have necessitated new grounds of rejections that are not based on prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "obtaining an identifier at a network service provider representing one or more users of a computer network; creating an anonymized identifier using the identifier obtained from the network service provider". The creating step must be performed by an entity other than the network service provider (please see paragraph 8 of the Office Action mailed 12/06/05 for the reason(s) as to why the network service provider of cannot create the anonymized identifier for the method of claim 1). However, the originally filed specification does not disclose an embodiment wherein the network service provider obtains an identifier and another entity (e.g., the collection engine) creates an anonymized identifier using the identifier obtained from the network service provider. Such an embodiment would require interaction between the network service provider and the collection engine so that the network service provider can transmit the obtained identifier to the collection engine, which is not disclosed by the originally filed specification. Thus, the limitation is considered new matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupp et al. ("INDEX: A Platform for Determining how People Value the Quality of their Internet Access") in view of Gabber et al (5,961,593) and Carr et al (5,835,915).

Regarding claim 1, Rupp discloses a method comprising: obtaining an identifier representing one or more users of a computer network at a network service provider, i.e., a supervisor node which determines who has access to which service (section 2.1, second paragraph); creating an anonymized identifier associated with the obtained identifier; collecting data being transmitted across the computer network at a collection engine (i.e., a billing gateway) connected to the network service provider; associating the anonymized identifier with the collected data if the collected data is sent to or from the one or more users to create a transaction record; and storing the transaction record in a database at the network service provider (fig. 1; section 2.1; section 2.2, third paragraph).

Rupp discloses that an anonymized identifier associated with the obtained identifier is created; however, Rupp does not disclose how the anonymized identifier is created. Gabber discloses creating an anonymized identifier using an obtained identifier (see Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rupp method such that the anonymized identifier is created using the obtained identifier, as taught by Gabber, so that the same user will be recognized by a consistent anonymized identifier.

Rupp discloses that the transaction record is stored in a database at the network service provider; however, Rupp does not disclose that the transaction record is stored in a database separate from the network service provider. Carr discloses that transaction records are stored in a database at a primary system and also in a duplicate database in a remote backup system separate from the primary system (col. 1, lines 16-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rupp method such that the transaction record is stored in a database in a remote backup system separate from the network service provider in addition to the database at the network service provider, as taught by Carr. Widespread disaster over a large geographic area that adversely affects the primary system will not affect the remote backup system.

Regarding claims 4 and 5, Gabber further discloses that that the anonymized identifier is created by applying a one-way hashing function to the obtained identifier and a value, which meets the limitation of a security key (col. 9, lines 9 and 23-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the method of Rupp such that the anonymized identifier is created by applying a one-way hashing function to the obtained identifier and a security key, as taught by Gabber. Please refer to motivation recited for creating the anonymized identifier using the obtained identifier as taught by Gabber in claim 1.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rupp in view of Gabber and Carr as applied to claim 1 above, and further in view of Astrom et al. (6,134,441). Rupp, Gabber and Carr do not disclose that the identifier representing the user is an MSISDN. Astrom discloses that an MSISDN is a unique identifier (col. 1, lines 56-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the obtained identifier is a MSISDN, as taught by Gabber, because it is a unique identifier representing a subscriber in GSM networks.

8. Claims 3 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupp in view of Gabber and Carr as applied to claim 1 above, and further in view of Ball et al. (6,446,200).

Regarding claim 3, Rupp, Gabber and Carr do not disclose that the obtained identifier is a static IP address. Ball discloses that a static IP address is a unique identifier (col. 14, lines 3-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the obtained identifier is a static IP address, as taught by Ball, because it is a unique identifier representing a network component.

Regarding claims 10, Rupp, Gabber and Carr in claim 1 do not disclose that the step of obtaining an identifier representing one or more users of a computer network includes: receiving packets sent by an authentication server and extracting an identifier from the received packets. Ball discloses a method for collecting data usage network comprising the steps of receiving packets sent by an authentication server and extracting an identifier from the received packets (see fig. 1 and col. 9, line 17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr to include the steps of receiving packets sent by an authentication server and extracting an identifier from the received packets, as taught by Ball, so that data of

various types and formats can be handled (col. 3, lines 32-35). Accordingly, the receiving and extracting are performed at the network service provider.

Regarding claims 11-12, they differ from claim 10 in that the authentication server is a RADIUS server and that the received packets are RADIUS packets. Ball further discloses that the authentication server is a RADIUS server and the received packets are RADIUS packets (see fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of claim 10 such that the authentication server is a RADIUS server and the received packets are RADIUS packets, as taught by Ball, because RADIUS is a well-accepted standard in the industry and is used across a number of different types of technologies (col. 3, lines 48-51).

Regarding claim 13, Rupp, Gabber and Carr do not disclose that the authentication server is a DHCP server. Ball discloses that the authentication server is a DHCP server (see fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that that the authentication server is a DHCP server, as taught by Ball, so that data of various types and formats can be handled (col. 3, lines 32-35).

9. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupp in view of Gabber and Carr as applied to claim 5 above, and further in view of Schneier ("Applied Cryptography").

Regarding claim 6, Rupp, Gabber and Carr do not disclose that the one-way hashing function is the SHA. Schneier discloses that SHA is a one-way hashing function (section 18.7, page 442). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the one-way hashing function is the SHA, as taught by Schneier, because the algorithm is used in the Secure Hash Standard and is required for Federal applications not requiring a digital signature.

Regarding claim 7, Rupp, Gabber and Carr do not disclose that the one-way hashing function is the MD4 algorithm. Schneier discloses that the MD4 algorithm is a one-way hashing function (section 18.4, page 436). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the one-way hashing function is the MD4 algorithm, as taught by Schneier, for better performance and simplicity.

Regarding claim 8, Rupp, Gabber and Carr do not disclose that the one-way hashing function is the MD5 algorithm. Schneier discloses that the MD5 algorithm is a one-way hashing function (section 18.5, page 436). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the one-way hashing function is the MD5 algorithm, as taught by Schneier, because it is an improved version of MD4.

Regarding claim 9, Rupp, Gabber and Carr do not disclose that the one-way hashing function is the DES algorithm. Schneier discloses that the DES algorithm can be used as a one-way hashing function (section 18.11, pages 446-447). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Rupp, Gabber and Carr such that the one-way hashing function is the DES algorithm, as taught by Schneier. The motivation for doing so would have been to use a symmetric block cipher algorithm as an alternative to other one-way hash functions.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d

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937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,983,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-13 of the '379 Patent contain(s) every element of claims 1-13 of the instant application and as such anticipate(s) claims 1-13 of the instant application.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,128,624 to Papierniak et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number

is 571-272-3802. The examiner can normally be reached on Mon-Fri:
10:00am-6:30pm.

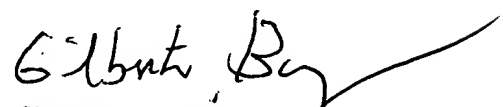
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD

Minh Dinh
Examiner
Art Unit 2132

MD
11/18/06


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
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